

REMARKS/ARGUMENTS

Applicant would like to thank the Examiner for the careful consideration given the present application. The application has been carefully reviewed in light of the Office Action, and amended as necessary to more clearly and particularly describe the subject matter that Applicant regards as the invention.

Claims 4, 5 and 12 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claim 4 recites “the phase conductors form N flat phases.” The Office action asserts that the term “flat” is ambiguous. With respect to electrical cables, “flat” is a term that is understood in the art to mean non-coaxial. A “flat” cable is shown in Fig. 2 and described at application page 8, lines 33-34. Applicant respectfully submits that the term “flat” does not render claim 4 indefinite. The requirement to distinctly claim means that the claim term must be discernible to one of ordinary skill in the art. Only when a claim term remains insolubly ambiguous without a discernable meaning after all reasonable attempts at construction should the term be deemed ambiguous. See MPEP § 2173.02. In the present case, the term “flat” has an understood meaning in the art and is clearly described in the specification and shown in the drawings. Applicant submits that claim 4 apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph. Applicant respectfully requests that the rejection of claim 4 under 35 U.S.C. 112, second paragraph, be withdrawn.

Claim 5 has been amended and no longer recites “such as.”

Claim 12 has been canceled.

Claims 1-8, 12 and 14 were rejected under 35 U.S.C. 102(b) as being anticipated by Elms or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Elms. Claim 1 requires “a

superconducting cable” and “superconducting phase conductors,” which are not taught, or otherwise rendered foreseeable, by Elms. Elms discloses a hybrid communications and power cable. Nowhere does Elms teach that its cable is suitable for use as a superconducting cable.

In practice, the arts of superconducting cables and conventional cables are very different and have little in common beyond the transportation of electricity. Elms teaches a hybrid cable for distributing communications signals and three-phase moderate-voltage alternating current. The cable includes a hollow conduit for receiving an optical fiber (1:53-65). A key element of the hybrid cable is the optical fiber, and the structure of the cable allows the optical fiber to be easily installed within the cable. It is unclear from the Office action how Elms’s cable could be modified to provide a superconducting cable as claimed.

Based on the teaching of Elms, a person of ordinary skill in the art would not consider modifying its hybrid communications and power cable to become a superconducting cable, and even if he did, he would not know how to make such a modification. Superconducting cables behave completely differently than conventional cables, i.e., they transport electricity virtually without loss. The person of ordinary skill in the art knows that the technology of conventional cables cannot be just simply transferred to the art of superconducting cables. There is no teaching in Elms about how to convert its cable to a superconducting cable or which features to combine with other subject matter relating to superconducting cables. The Office action relies on improper hindsight in rejecting claim 1.

The Examiner is respectfully reminded that a prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. See MPEP § 2141.02.VI. In rejecting a claim as obvious, it is improper to select features from one prior art document out of context with the total teaching of the document. Prior art

documents cannot be considered as a reservoir of features which the person of ordinary skill in the art would find obvious to combine in any combination irrespective of the teaching in the documents. The specific combination of such features may be highly inventive.

In view of the discussion above, applicant submits that claim 1 is allowable over Elms. Claims 2-6 and 8 depend from claim 1. The arguments provided above with respect to claim 1 are also applicable to claims 7 and 14. Claim 12 has been canceled.

Claims 10, 11, 13 and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Elms. Claims 10, 11, 13 and 15 depend from claim 1.

Claims 1-15 were rejected based on nonstatutory obviousness-type double patenting over claims 1-15 of USPN 6,684,486. Applicants intend to submit a terminal disclaimer if necessary.

In light of the foregoing, it is respectfully submitted that the present application is in condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge same to our Deposit Account No. 16-0820, our Order No. NKTR-34155US1.

Respectfully submitted,
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